UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/20/2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/20/2009 have been fully considered but they are not persuasive.

Applicant states that claim 16 should be part of the group of claims rejected under Laumen in view of Gabriel in view of Fenton.

The Examiner respectfully disagrees. Claim 16 is rejected on the same basis as claim 7, and claim 7 is rejected by Laumen, please see rejection. Since claim 16 is dependent from claim 12, and claim 12 is rejected under Laumen in view of Fenton, claim 16 is under the correct heading.

Applicant argues on page 6 that "Applicant submits that modification of Laumen et al. as taught by Fenton to include one polled e-mail server would render Laumen et al. unsatisfactory for its intended purpose of recalling or replacing an MMS message that has already been sent. MPEP §2143.0 I(v) provides "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)) The intended purpose set forth in Laumen et al. (e.g., recalling or include sending of a message from a polled e-mail server to a pushed e-mail server)".

The Examiner respectfully disagrees. Modifying the server of Laumen to be a polled email server, as taught by Fenton does not render the system of Laumen inoperable. Since the modification merely allows the user to know in a variety of ways when an email is present **(0100)**. Laumen still teaches the retraction of emails.

Applicant argue on page 7 that "No teaching or suggestion in either Laumen et al. or Gabriel et al. is found for a subscriber account being established for each subscriber on a push mail sever, wherein "the subscriber account including the telephone number of at least one telecommunication terminal and the <u>original</u> e-mail address of the recipient," as found in claim 2".

The Examiner would like to state that the amendment of claim 2 has rendered the claim indefinite. Please see the USC 112 rejection below. The Examiner would like to state that Gabriel teaches setting up accounts for recipients, to send and receive messages, as well as setting up a service to have messages sent to the user's email **(0233 and 0234)**. The account can be set up using a telephone number **(0038)**. Since the messages will be delivered to the email address, then both elements a telephone number and email address have been met, and since an account is set up, the account is clearly established.

Thus the claimed limitations have been met.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the original email address" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. Neither claim 1 nor claim 2

recite "an original email address". Also it is not clear whether "the original email

address" of claim 2 is referring to "the email address" of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-14 and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Laumen et al. (US 2003/0086438 herein Laumen) in view of

Fenton et al. (US 2003/0193951 herein Fenton).

Claim 12, Laumen discloses a device for immediate delivery of e-mails to a

telecommunication device of a recipient via at least one telecommunication network

(Abstract, 0008, where Laumen discloses mail transfer protocol), Laumen

discloses with an e-mail server for transmitting the e-mails from a sender to the recipient

(0041, Fig. 4: 1 & 2, where Laumen discloses a sender (UAA) and a Relay/Server

(RSA)), Laumen discloses a telecommunication network including MMS or WAP push

systems **(0041, Fig. 4: 2, 12 & 11, where Laumen discloses a UAB, MMS servers**

using WAP), Laumen discloses a push server connected with the e-mail server for

immediate delivery of the e-mails received by the e-mail server to the communication

terminal of the recipient **(Fig. 4: 12 & 11, where Laumen discloses MMS servers)**.

Laumen does not explicitly disclose e-mails received by the polled e-mail server.

In an analogous art, Fenton discloses e-mails received by the polled e-mail

server **(0100, where Fenton discloses Emails received on an external server,**

which is polled). Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify Laumen to use polling as taught by

Fenton so as to use various methods for discover of new messages on external servers

(0100).

Claim 13, Laumen discloses wherein the telecommunication terminal is a mobile

telecommunication terminal **(0006, where Laumen discloses a mobile radio)**.

Claim 14, Laumen discloses wherein the telecommunication terminal is a landline

telecommunication terminal **(0013, where Laumen discloses a computer)**.

Claim 16, as analyzed with respect to the limitations as discussed in claim 7.

Claims 1-8, 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Laumen et al. (US 2003/0086438 herein Laumen) in view of Gabriel et al. (US

2004/0082348 herein Gabriel) in view of Fenton.

Claim 1, Laumen discloses a method for immediate delivery of an e-mail to a

telecommunication device of a recipient via at least one telecommunication network

(Abstract, 0008, where Laumen discloses mail transfer protocol), Laumen

discloses wherein the e-mail is transmitted from a sender via an e-mail server to the

recipient **(0041, Fig. 4: 1 & 2, where Laumen discloses a sender (UAA) and a**

Relay/Server (RSA)), Laumen discloses delivering the e-mail to a telecommunication

terminal of the recipient via conventional MMS or WAP push systems **(0041, Fig. 4: 2,**

12 & 11, where Laumen discloses a UAB, MMS servers using WAP), Laumen

discloses in that in that the e-mails are forwarded from the e-mail server to a specially

configured push mail server based on the e-mail address of the recipient **(0363, Fig. 4:**

2 & 12, where Laumen discloses receiving address in the message and sender-

end RSA and recipient-end RSA).

Laumen does not explicitly disclose from where they are delivered to the

telecommunication terminal based on a telephone number, which is included in the e-

mail; e-mails are forwarded from a polled e-mail server.

In an analogous art, Gabriel discloses from where they are delivered to the

telecommunication terminal based on a telephone number, which is included in the e-

mail **(0233, where Gabriel discloses sending the message to the intended**

recipient, after parsing the message). Therefore, it would have been obvious to one

of ordinary skill in the art at the time the invention was made to modify Laumen by

forwarding emails to devices based on addresses as taught by Gabriel so as to send

messages to incompatible and distant cellular networks **(0007)**.

Laumen in view of Gabriel does not explicitly disclose e-mails are forwarded from

a polled e-mail server.

In an analogous art, Fenton discloses e-mails are forwarded from a polled e-mail

server**(0100, where Fenton discloses Emails received on an external server, which**

is polled). Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Laumen in view of Gabriel to use polling as

taught by Fenton so as to use various methods for discover of new messages on

external servers **(0100)**.

Claim 2, Laumen discloses the e-mail address of the recipient **(0347).**

Laumen does not explicitly disclose wherein a subscriber account is established

for each subscriber on the push mail server, the subscriber account including ~~at least~~

the telephone number of at least one telecommunication terminal and the original email

address of the recipient.

In an analogous art, Gabriel discloses wherein a subscriber account is

established for each subscriber on the push mail server **(0233, where Gabriel**

discloses account information), Gabriel discloses the subscriber account including ~~at~~

~~least~~ the telephone number of at least one telecommunication terminal and the original

email address of the recipient **(0233, where Gabriel discloses a phone number, and**

0234, where Gabriel discloses sending messages to the user's email). Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify Laumen to include account information and telephone numbers as

taught by Gabriel so as to send messages to incompatible and distant cellular networks

(0007).

Claim 3, Laumen discloses wherein forwarding of the e-mail from the e-mail

server to the push mail server is controlled by a device and by applying forwarding rules

(Fig. 4: 2 where forwarding of emails is based is done by a RSA).

Claim 4, Laumen does not explicitly disclose wherein the push mail server

determines the telephone number of the telecommunication terminal of the recipient

from the employed push mail address.

In an analogous art, Gabriel discloses wherein the push mail server determines

the telephone number of the telecommunication terminal of the recipient from the

employed push mail address **(0233, where Gabriel discloses parsing the address)**.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Laumen to include parsing the address as taught by

Gabriel so as to send messages to incompatible and distant cellular networks **(0007)**.

Claim 5, Laumen discloses wherein the push mail server is connected to the

MMS or WAP push systems of the employed telecommunication network **(Fig. 4: 2 &**

12, where Laumen discloses a MMS-WAP push system).

Claim 6, Laumen discloses wherein the function of the push mail server is

integrated directly in the existing e-mail server **(0006, 0007, Fig. 2: 2,12, where**

Laumen discloses that it is well known to have a relay and server as one

configuration).

Claim 7, Laumen inherently discloses wherein the push mail server encapsulates

the e-mail in a suitable content type, so that the e-mail can be transmitted via MMS or

WAP push format **(0041, where Laumen discloses delivery using WAP)**.

Claim 8, Laumen discloses wherein a "message/rfc822" is employed as a

content type **(0008, 0373, where Laumen discloses an email address)**.

Claim 10, Laumen discloses wherein a conventional WAP client or MMS client,

which detects and processes encapsulated e-mails, is installed in the

telecommunication terminal **(0041, where Laumen discloses an UAB at the terminal)**.

Claim 11, Laumen discloses wherein, if message units encapsulated with the special content type are detected, the e-mail contained therein is extracted and transmitted to the e-mail client of the telecommunication terminal **(0347, where Laumen discloses delivery via an email address)**.

Claim 15, as analyzed with respect to the limitations as discussed in claim 2.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laumen in view of Gabriel in view of Fenton in view of Ala-Luukko et al. (US 2003/0064706 herein Luukko).

Laumen in view of Gabriel in view of Fenton does not disclose wherein the push mail server includes a billing mechanism, which is used to produce toll tickets for the billing system of telecommunication network operators or other service providers.

In an analogous art, Ala-Luukko discloses wherein the push mail server includes a billing mechanism, which is used to produce toll tickets for the billing system of telecommunication network operators or other service providers **(0023, where Ala-Luukko discloses a billing tickets)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laumen in view of Gabriel in view of Fenton to include billing tickets as taught by Ala-Luukko so as to track message transactions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final

action is set to expire THREE MONTHS from the mailing date of this action. In the

event a first reply is filed within TWO MONTHS of the mailing date of this final action

and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date

the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the

statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MEHMOOD B. KHAN whose telephone number is

(571)272-9277. The examiner can normally be reached on Monday - Friday 8:30 am -

5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Lester Kincaid can be reached on 571-272-7922. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B. K./
Examiner, Art Unit 2617

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617